



GREENBLUM & BERNSTEIN, P.L.C.
1941 ROLAND CLARKE PLACE
RESTON, VA 20191

MAILED

SEP 21 2012

In re Patent No. 6,285,285
Issue Date: September 4, 2001
Application No. 09/647,921
Filed: November 13, 2000
Attorney Docket No.: P20085

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed February 1, 2012, under 37 CFR 1.378(b), to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued on September 4, 2001. The second maintenance fee due could have been paid during the period from September 4, 2008 to March 3, 2009 or, with a surcharge during the period from March 4, 2009 to September 4, 2009. Accordingly, this patent expired on September 4, 2009 for failure to timely remit the second maintenance fee.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by:

- (1) The required maintenance fee set forth in § 1.20 (e) through (g);
- (2) The surcharge set forth in § 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks item (3) above.

Petitioner, asserts that the system wherein the U.S. firm responsible for payment of the maintenance fees, Greenblum & Bernstein, was changed after receipt of the letters patent and after the payment of the first maintenance. Petitioner asserts further that therefore, the French Law firm, Cabinet John Schmitt, engaged by the patentee did not enter payment of the maintenance fee due dates into their docketing system and that therefore they did not receive the normal triggers to engage the services of CPA, the annuity service, as it related to the docketing and payment of maintenance fees for the instant patent.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

In this instance, to establish unavoidable delay in payment of the maintenance fee, petitioners have not shown the circumstances surrounding the transfer from Greenblum & Bernstein to Cabinet John Schmitt and that there was a system in place during the transition period from the time Greenblum & Bernstein advised on March 16, 2006 of the new maintenance fee policy effective January 2007 until the time payment of the maintenance fee was due September 4, 2008.

By their own admission however, petitioners assert that after Greenblum & Bernstein paid the first maintenance fee on March 3, 2005, on April 20, 2005, in reporting the payment of the first maintenance fee, Greenblum & Bernstein informed Cabinet John Schmitt that payment of the second maintenance fee would be due, without surcharge by March 4, 2009. The policy was acknowledged by Cabinet John Schmitt and Cabinet John Schmitt was put on notice specifically as it relates to the instant patent, but no system was put in place to track/monitor all of the patents in the patentee's portfolio or all of the patents for which Greenblum & Bernstein previously handled.

The statement provided by Helen Agniel, an employee of the French law firm of Cabinet John Schmitt does not support the allegations that the delay in paying the maintenance fees was unavoidable or that she and her employer exercised reasonable care in their duties with respect to this patent.

Additionally, a review of the record reveals that the address for fee purposes remains that of Greenblum & Bernstein and that a maintenance fee reminder was mailed to that address on March 16, 2009. Although it was sent as a courtesy it raises the question as to whether or not Greenblum & Bernstein retained the responsibility for payment of the maintenance fees. Even if Greenblum & Bernstein was not responsible, it hasn't been shown why Greenblum & Bernstein failed to forward the Maintenance Fee Reminder to Cabinet John Schmitt.

As has been noted above, no supporting documentation has been provided to support the allegations that the responsibility for payment of the maintenance fees was transferred, or that in that transfer, Cabinet John Schmitt, as prudent and careful practitioners, took adequate steps in the docketing of this patent and to prevent the delay in the payment of the maintenance fees.

⁴Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

⁵Id.

For all the reasons listed above, petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable. There is a distinct difference between an unavoidable delay which, had there been reasonable care exercised, could not have been prevented and one that was the result of a mistake. However, in view of the above and since petitioner has not provided enough information for a determination that reasonable care was in fact exercised to ensure that the maintenance fee would be paid timely and that therein the delay was unavoidable, the argument fails.

Assuming that the failure to submit the maintenance fee payment to the USPTO was a clerical error, as noted in MPEP 711.03(c) §(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.⁶

An adequate showing as it relates to an error on the part of an employee requires:

- (1) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;
- (2) Petitioner must supply a thorough explanation of how they came to be responsible for matters related to this patent including the ultimate responsibility for payment of maintenance fees and how it is that this matter was not placed in their docketing system; and
- (3) Petitioner must supply information regarding the training provided to the personnel responsible for the creation and transfer of the patent records and must describe the work which was used to assure proper execution of assigned tasks.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

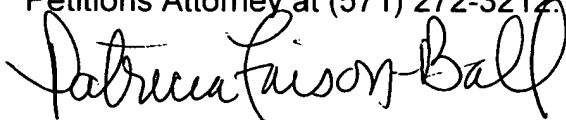
⁶See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned
Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with a large, prominent "P" at the beginning.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions